

**REMARKS**

**Status of the Claims**

Claims 20-37 are pending in the application. Claim 20 was amended in the response accompanying the RCE.

**Objection to Scope of Data**

In the Advisory Action, the Examiner stated that the test results submitted via Declaration "are not commensurate with the scope of the claims, as the inventive and comparative compositions only contain 1% by weight of tertiary amine, while the claimed compositions can comprise from 0.5 to 8 % by weight of the tertiary amine." Applicants filed a request for suspension of action for three months in order to generate test data commensurate in scope with the claims. This additional data is submitted via the attached 1.132 Declaration.

In the additional data, four transmission fluid formulations, were tested in the LFW-1 friction test (explained in detail at page 15 of the present specification). Two example inventive fluids (Ex. 1 and 2) that contained a tertiary amine having one methyl group and two long-chain groups were tested at 1 and 5 wt% of the tertiary amine. Two comparative example fluids (Ex. 3 and 4) that contained a tertiary amine having two methyl groups and one long-chain group were tested also at 1 and 5 wt% of the tertiary amine.

A difference of about 6% was found between the "New" formulation containing 1.0 wt% of a tertiary amine having one methyl group (Example 1) and the "New" formulation containing 1.0 wt% of a tertiary amine having two methyl groups (Example 3). A difference of about 12% was found between the "New" formulation containing 5.0 wt% of a tertiary amine having one methyl group (Example 2) and the "New" formulation containing 5.0 wt% of a tertiary amine having two methyl groups (Example 4). A difference of less than 1% was found between the "Aged" 1.0 wt% amine formulations (Example 1 vs. Example 4), and a difference of about 3% was found between the "Aged" 5.0 wt% amine formulations (Example 2 vs. Example 4).

Further, as is apparent from viewing the Figures, the difference in static to dynamic friction ratio of the inventive fluids is greater for new and aged (see Figures for Examples 1 and 2) when compared to the difference in static to dynamic friction ratio for new and aged of the comparative fluids (see Figures for Examples 3 and 4) at equivalent treat rates. In the inventive fluid figures, this effect is shown, for example, by a greater difference in static friction between the new and aged fluids when compared to the small difference in static friction between the new and aged fluids of the comparative fluid. Further, the dynamic friction of the inventive fluids changes from a dip to a plateau as the fluid ages (see Figures for Examples 1 and 2). This is desirable. In the comparative fluids, the change is much less pronounced (see Figures for Examples 3 and 4). The new and aged fluids are very similar in performance, which indicates little change. Such change between new and aged fluid performance demonstrates the benefits of the presently claimed invention.

Accordingly, there is a difference between the tertiary amines, and the selection of a tertiary amine as defined in the present claims does bring about an unexpected technical effect. And this technical effect is realized over the claimed wt% range.

#### **Summary of Rejections**

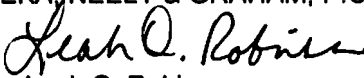
In the Office Action, claims 20-35 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 4,177,153 to Lowe ("Lowe") in view of U.S. Patent No. 4,795,583 to Papay ("Papay") and U.S. Patent No. 6,844,301 to Field et al. ("Field"). Claim 36 is rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lowe in view of Papay and Field as applied to claims 20-35, and further in view of U.S. Patent No. 5,344,579 to Ohtani et al. ("Ohtani"). Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claims 20-35, and further in view of U.S. Patent No. 6,225,266 to Watts et al. ("Watts").

All rejections are respectfully traversed. Reconsideration and allowance of claims 20-37 are respectfully requested in view of the amendments and the previous remarks made in the response filed on September 16, 2009 and the presently filed Declaration.

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

#### **FEES**

It is believed that there are no fees associated with the present response. However, if this is incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355.

Respectfully submitted,  
LUEDEKA, NEELY & GRAHAM, P.C.  
By:   
Leah O. Robinson  
Reg. No. 44,990

Date: 04/07/10  
P.O. Box 1871  
Knoxville, TN 37901  
Phone (865) 546-4305  
Fax (865) 523-4478